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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,888	12/05/2001	Ronald Huner	584.12-US1	5270

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,888

Applicant(s)

HUNER, RONALD

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/7/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 December 2004 has been entered.

Election/Restrictions

Applicant's election of diphenylcresylphosphate in the reply filed on 7/05/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17 -55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chopra 5768678 in view of any of Ezis 5358685, Hara 3859056, Mueller 3690930, Halberstadt 2666714, Segura 3573959 and Bordenca 3,401051, and further in view of Bradshaw 3669765 and Copelin 2789070.

Chopra discloses MnS is susceptible to damage by oxidation and that such affects it use (col. 5, lines 7-32). Thus Applicant's problem was already known.

It is well known in the power metallurgy art to coat powders to protect against oxidation. See Ezis paragraph spanning cols. 6-7, Hara col. 3, lines 52-57; Mueller,

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abstract, Halberstadt, col. 2, lines 35-45; Segura, col. 2, lines 13-17; Bordenca, col. 2, lines 36-43; and Koester, paragraph spanning cols. 1-2. Thus applicant's solution to the process was well known. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

It would have been obvious to coat the Chopra MnS and/or the prior art MnS to prevent/inhibit oxidation since such coating is a known solution to the oxidation of powders problem. As to the amount of coating material – it would have been obvious to perform routine experimentation to determine the necessary/optimal amount of coating: this applies to the relevant dependant claims that further limit the amount.

Copelin discloses that phosphate coating are widely used (col. 1, lines 22-23) to protect metals. Bradshaw discloses using acid can serve to clean the surfaces (col. 3, lines 22-24). It would have been obvious to use acid phosphates (i.e. a phosphoric acid ester) as taught by Copelin and Bradshaw because such is a well known treating coating agent that serves to clean the metal before coating it.

Also, various secondary references teach other compounds that appear to read on the non-elected species of claim 1. For example: Koester teaches a polymer (see abstract): it would have been obvious to perform routine experimentation to determine the optimal polymer. Segura, paragraph spanning cols. 2-3 discloses various low melting point polymers as well as the polyenes of col. 2, line 71. And Halbertstadt, col.

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5, lines 24-28. It would have been obvious to use any of the coating of the secondary references for their known effectiveness.

Claims 18-19: See Chopra, col. 4, line 25.

Claim 20 further limits the polymer – but does not require the agent to be the polymer – nor does it limit any of the other agents of claim 17. Thus claim 20 does not definite over the phosphates of Copelin and Bradshaw. Also the secondary references have compounds that read on polyaliphatic compounds as well as the alcohols and oils of claim 17. Similarly for claims 21-31: they only limit specific genus's and do not require the claimed agent to be from the limited species.

Claim 32 is clearly met. Or if the mixing is not clearly met: it would have been obvious to thoroughly mix/coat the material so as to ensure that all of the surfaces are coated – so as to ensure that no surface can be oxidized.

Claims 33-50 are met for the reasons given above.

Claims 51- 55: it deemed that such is inherently met by col. 1, lines 37 –50 of Chopra.

Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storstrom 5480469 (or Uenosono 5,938,814).

See the prior rejections for the manner in which the references are applied.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 51-52 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed embodiments, does not reasonably provide enablement for the single means-type claim. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

FROM MPEP 2164.08(a) Single Means Claim

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Presently, the claims are essentially single-step claims which parallel the single-means claim on IN RE HYATT. Claims 51-52 cover every conceivable step for achieving the stated purpose – but the specification only discloses at most those steps known to the inventor.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by "a...characteristics" - it is unclear if it one or more must be improved.

Response to Arguments

Applicant's arguments filed 27 September 2004 have been fully considered.

It is argued that the material of claim 55 is superior to that of Uenosono. Applicant should provide evidence which proves this to be true. Assertions of different properties cannot take the place of evidence. Such evidence probably should not be based on stored MnS – as Uenosono does not describe that the MnS is stored or oxidized. It appears that Applicant merely invented an improved process (i.e. one that permits longer storage of the starting powder) .

Regarding Storstrom – it is argued that since the coated MnS is new, then the combination of the MnS with other ingredients is new. This is not accurate. One looking at the Storstrom mixed powder would have no way of knowing the order in which the ingredients are added.

The courts have been holding for quite some time that “—in spite of the fact that a product-by-process claim may recite only process limitations, it is the product which is covered by the claim and not the recited process steps.” (In re Hughes, 182 USPQ). Also, “—patentability of a claim to a product does not rest merely on a difference in the

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method by which that product is made. Rather, it is the product itself which must be new and unobvious." (In re Pilkington, 162 USPQ 147). The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

Specifically, a powder made by mixing Storstrom's ingredients all at once would be substantially indistinguishable from a powder made by mixing some of the additive to the MnS, then adding Fe, the remaining additive and all other ingredients. In other words, claim 53 only requires two powders – and at least one of them must be coated. One looking at a powder cannot tell when a coating was added to it. Storstrom clearly has that. Or still further: claim 17 permits only 10 % coating agent at a maximum – but Claim 53 is comprising in nature and is open to having much more than 10% agent added to it.

Conclusion

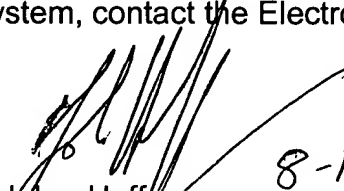
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hayami, Chalasani, Koester, Ozaki are cited as being directed to coating powders. Danforth is cited for using one of the claimed phosphates.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

8-10-05

jmh